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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

<b>IN RE PATENT APPLICATION OF:</b>	Kamran AMJADI	<b>ATTORNEY DOCKET No:</b>	031792-0311576
<b>SERIAL No.:</b>	09/251,480	<b>CONFIRMATION No.:</b>	3291
<b>FILING DATE:</b>	FEBRUARY 17, 1999	<b>EXAMINER:</b>	KHANH Q. DINH
		<b>ART UNIT:</b>	2451
<b>FOR:</b>	INCENTIVE NETWORK		

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**APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41**

**MAIL STOP APPEAL BRIEF – PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Dear Sir:

This Reply Brief is being timely filed within two months of the Examiner's Answer<sup>1</sup> (hereinafter "Answer"), mailed August 21, 2008. This Brief responds to the new points raised by the Examiner in the Answer.

**I. STATUS OF CLAIMS**

Pending claims 1-59 stand rejected, and are on appeal.

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<sup>1</sup> On the title page (page 1) of the Answer, the Examiner has incorrectly listed the registration number for Bradford C. Blaise as "(Reg No. 32,694)." The correct registration number for Bradford C. Blaise is 47,429. Registration No. 32,694 is the registration number for James G. Gatto, who is also an attorney of record in the above-referenced application. Additionally, on the title page of the Answer, it should be noted that the Appeal Brief filed on November 14, 2007 (hereinafter "Appeal Brief") is appealing from the Office Action mailed November 17, 2006 (hereinafter "Office Action"), *not* 11/14/2006.

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A. Claims 1-36, 39-41, 44-50, and 52-59 stand rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over U.S. Patent No. 5,970,469 to Scroggie *et al.* (hereinafter "Scroggie") in view of U.S. Patent No. 5,949,875 to Walker *et al.* (hereinafter "Walker") [Office Action, pg. 3, ¶4; Answer, pg. 3, ¶2].

B. Claims 37-38, 42-43, and 51 stand rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over the combination of Scroggie and Walker, further in view of U.S. Patent No. 6,055,573 to Gardenswartz *et al.* (hereinafter "Gardenswartz") [Office Action, pg. 14, ¶5; Answer, pg. 16, ¶3].

## II. RESPONSE TO EXAMINER'S ARGUMENTS

### A. OVERVIEW

In the Answer, just as in the Office Action, the Examiner has failed to meet the requisite burden<sup>2</sup> of establishing a *prima facie* case of obviousness. In particular, the Examiner has failed to demonstrate that Walker, which is relied on for the rejection of all of the pending claims, is within the scope and content of the prior art. It clearly is not.

Assuming *arguendo* that Walker qualifies as analogous art (which Appellant does *not* concede), the Examiner has provided no viable, rational underpinning to support the articulated reason for modifying Scroggie to include the alleged teachings of Walker. In the

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<sup>2</sup> It is well established that "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant." *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (discussing *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)).

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Answer, the Examiner fails to even address Appellant's arguments concerning the legally improper, hindsight-driven combination of Scroggie and Walker.

Even if the proposed combination of Scroggie and Walker were deemed legally proper (which Appellant does *not* concede), the references, even if combined, still fail to disclose, teach, or suggest all of the claim elements. In the Answer, the Examiner provides no evidence to rebut Appellant's argument that neither Scroggie nor Walker, either alone or in combination, teach or suggest *at least* the use of a network ID ("NID") in connection with a determination of what subset of incentives are to be made available (to a user) in response to a request (for access to incentives) from a client device through a network server having an associated NID.

Additionally, in an apparent recognition of the weakness of the rejection as it pertains to the claim recitations concerning the at least two (or a plurality of) network servers, the Examiner takes a *new* position in the Answer, now indicating that the recitation of "at least two network servers" in independent claims 1, 11, and 18 has not been given any patentable weight [Answer, pgs. 17-18]. This position is without merit.

In the Answer, the Examiner also retreats from his previous interpretation of the teachings of Scroggie, and now newly recites that Scroggie discloses one network server, and *not* multiple (or at least two) network servers. Because the Examiner had previously relied on the teachings of Scroggie alone for the disclosure of at least two (or a plurality of) network servers, and *not* on any secondary references, the Examiner now attempts to salvage the rejection by improperly relying on a misplaced "duplication of parts" argument,

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and erroneously alleging that additional network servers provide no patentable significance. This position trivializes Appellant's invention and is without merit.

For at least each of the foregoing reasons, the Examiner has failed to meet the requisite burden of establishing a *prima facie* case of obviousness. The rejection of claims 1-59 under 35 U.S.C. § 103 is therefore improper and must be reversed.

**B. THE EXAMINER HAS FAILED TO ADEQUATELY ADDRESS THE RECITATIONS OF INDEPENDENT CLAIMS 18, 34, 39, 44, 48, and 52-53.**

In the Office Action [at pg. 8] and in the Answer [at pg. 9], the Examiner recites that "[c]laims 11-20 are rejected for the same reasons set forth in claims 1-10 respectively." While independent claim 11 includes similar recitations to that of independent claim 1, it is not clear to Appellant what the Examiner is relying on for various recitations of independent claim 18.

With regard to independent claim 34, the Examiner *only* references Scroggie's disclosure of coupons, discounts, and awards and does not address *each* of the claim recitations [Office Action, pg. 10; Answer, pg. 11]. The Examiner then: (1) references the rejection of independent claim 34 for the rejection of independent claim 39; (2) references the rejection of independent claim 39 for the rejection of independent claim 44; (3) references only the disclosure of a database in Scroggie for the rejection of independent claim 48; and (4) references the rejection of independent claims 34 and 39 for the rejections of independent claims 52 and 53, respectively [Office Action, pg. 10; Answer, pg. 11].

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The rejections of independent claims 18, 34, 39, 44, 48, and 52-53 should therefore be reversed for at least the reason that the Examiner has failed to address all of the recitations in each of these claims. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. (BNA) 494, 496 (C.C.P.A. 1970).

Despite the improper rejections of the foregoing claims, Appellant has addressed herein the many deficiencies of the alleged Scroggie/Walker combination with regard to the features recited in *each* of the independent claims.

**C. THE EXAMINER HAS FAILED TO DEMONSTRATE THAT WALKER IS WITHIN THE SCOPE AND CONTENT OF THE PRIOR ART**

The Examiner has ignored the well-established legal test for determining whether a particular reference is within the appropriate scope of the prior art. As stated in the Appeal Brief [at pg. 42], a two step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is "within the field of the inventor's endeavor." Second, assuming the reference is outside that field, it must be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. (BNA) 313, 315 (Fed. Cir. 1986). The Examiner has addressed neither inquiry in the Answer. This is clear legal error.

In the Appeal Brief, as required by the proper legal test for analogous art, Appellant articulated the field of endeavor for both Appellant's claimed invention and for Walker [Appeal Brief, pg. 42], as well as the problems with which each were concerned [Appeal

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Brief, pgs. 42-45]. In the Answer, while arguing that Walker is analogous art with respect to Appellant's claimed invention, the Examiner did *not* refute that these are the proper fields of endeavor, or problems. Rather, after restating the legal test, the Examiner simply recited:

In this case, the Walker reference discloses a method for access billings or information, goods or services made available for a user in the computer network.

[Answer, pg. 25].

In this one-sentence "analysis," the Examiner addressed neither the *fields of endeavor* of the claimed invention and Walker, nor the *problems* with which the claimed invention and Walker were concerned. The record is devoid of any evidence establishing that one of ordinary skill in the art would reasonably have looked to Walker (which is outside of Appellant's field of endeavor) when considering the problem(s) of providing network-wide access to incentives (*e.g.*, coupons) to consumers who access a common incentive host server via a client device (*e.g.*, a personal computer) through any one of a number of different other network servers (*e.g.*, network servers on which different web sites are hosted) within a network.

When the proper legal test is applied to Walker, and when the uncontested fields of endeavor and problems are analyzed, Walker can *not* properly be considered analogous art. As such, in view of the arguments presented in the Appeal Brief [pgs. 41-45], it is clear that the Examiner has not proven an essential element of the obviousness test, *i.e.*, that Walker is within the scope and content of the prior art. As a result, Walker can *not* be properly considered in an obviousness analysis. "The combination of elements from non-analogous

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sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness." *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). The rejection of claims 1-59 under 35 U.S.C. § 103(a) is legally improper and should therefore be reversed for at least this reason.

**D. THE EXAMINER HAS FAILED TO PROVIDE ANY VIABLE, RATIONAL UNDERPINNING TO SUPPORT THE ARTICULATED REASON FOR MODIFYING SCROGGIE TO INCLUDE THE TEACHINGS OF WALKER.**

Assuming arguendo that Walker qualifies as analogous art (which Appellant does *not* concede), the Examiner has failed to provide any viable, rational underpinning to support the articulated reason for modifying Scroggie to include the teachings of Walker. The Examiner's failure to even address Appellant's arguments [Appeal Brief, pgs. 46-48] concerning the legally improper combination of Scroggie and Walker in the Answer is very telling with regard to the impropriety of the alleged combination, and the overall weakness of the rejection.

To emphasize again why the Examiner's alleged motivation for modifying Scroggie is legally deficient, it is helpful to highlight certain features of Appellant's invention. As noted in the Appeal Brief [*e.g.*, at pg. 3], aspects of Appellant's invention relate to computer-implemented methods, systems, and apparatus for providing secure, targeted, and trackable incentives (*e.g.*, coupons) to consumers who access a common incentive host server via a client device (*e.g.*, a personal computer) through any one of a number of different other network servers (*e.g.*, network servers on which different websites are

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hosted) [Specification, *e.g.*, pg. 4, lines 10-15]. In one implementation, each registered client device has a unique ID (UID) associated with it, and each network server has a network ID (NID) associated with it [Specification, *e.g.*, pg. 14, lines 11-14].

The incentive host server may, according to one aspect of the invention, store information about an entire collection of coupons that are available through the network. [Specification, *e.g.*, pg. 14, lines 8-9; and FIG. 4]. For any specific request, however, only a portion of the coupons may be made available based on information associated with the UID (*e.g.*, demographic information and/or prior activity) and the NID (*e.g.*, the website or other network server from which the request was made) [Specification, *e.g.*, pg. 15, lines 7-15]. Accordingly, selected coupons may be made available (or not) for a user based on demographic targeting (*e.g.*, using information associated with the UID), as well as, for example, the website from which the user made the request.

With regard to the rejection of the independent claims, the Examiner explicitly concedes that Scroggie fails to disclose "a network server identifier (NID) to identify available incentives." The absence of such a feature in Scroggie is not surprising because, given the system architecture of Scroggie, there is no need for a NID as users of Scroggie's system access the incentive distribution server (300) *directly* [Scroggie, *e.g.*, col. 11, lines 51-53]. Unlike the incentive network as disclosed and claimed by Appellant, Scroggie does *not* disclose a common incentive server accessed via one of any number of network servers (*e.g.*, other websites), much less network servers that each have their own NID. As a result, it would not make sense (given the disclosed architecture of Scroggie) to have a NID parameter used to filter coupons for a particular request. Nowhere in the record has the



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Examiner addressed how the existing system architecture of Scroggie could even implement the use of NIDs.

In a clear exercise of hindsight reconstruction, and apparently without consideration of the system architecture of Scroggie, the Examiner turns to the disclosure of Walker in an attempt to try and recreate Appellant's claimed invention. The Examiner's characterization of the relied upon passages of Walker, however, is simply unsupported. Walker fails to even disclose incentives, much less a NID used to identify available incentives. Rather, Walker is concerned with providing a new and improved system for selling digital data [Walker, col. 2, lines 62-63]; an object apparently accomplished by facilitating the purchase of information on a data network by linking 900-number calls to the activation of codes necessary to retrieve the information [Walker, col. 5, lines 16-19]. The Examiner's alleged motivation fails to provide any reasoning whatsoever as to why one of ordinary skill in the art would modify Scroggie to include the ability to track codes necessary to manage the purchase of information over a network, when Scroggie is not concerned with the purchase of information over a network.

The Examiner does not respond to or refute any of the foregoing points concerning the improper Scroggie/Walker combination in the Answer. In view of the foregoing, it is clear that the Examiner has failed to provide any explicitly articulated reasoning with a rational underpinning to support the legal conclusion of obviousness. As such, the rejection of claims 1-59 under 35 U.S.C. § 103(a) is legally improper and should be reversed.

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**E. THE EXAMINER HAS FAILED TO ESTABLISH THAT THE ALLEGED COMBINATION OF SCROGGIE AND WALKER DISCLOSE, TEACH, OR SUGGEST ALL OF THE CLAIM FEATURES**

Assuming arguendo that it were deemed legally proper to modify Scroggie to include the *alleged* teachings of Walker in the manner set forth by the Examiner, the rejection under 35 U.S.C. § 103(a) would still be improper because the combined references fail to disclose, teach, or suggest all of the claim features. The Examiner has failed to demonstrate otherwise.

1. Neither Scroggie Nor Walker Teach or Suggest Determining Available Incentives Based on a NID.

Each of independent claims 1, 8, 11, 18, 21, 34, 39, 44, 48, 52-54, and 57 explicitly recites using at least a NID to determine/identify available incentives (or coupons). As noted in the Appeal Brief [at pgs. 49-55], the passages of Walker [*i.e.*, Abstract; FIG. 5; col. 5, lines 7-43; and col. 6, line 21 – col. 7, line 56] relied upon by the Examiner in an attempt to cure this acknowledged deficiency of Scroggie clearly do not state what the Examiner alleges. In the Answer, the Examiner provides no defense of his position, and responds to Appellant's arguments by merely "cutting and pasting" the same rejection without comment. The Examiner does not even address the deficiencies of Walker.

Again, Walker appears to rely on the use of codes to manage the information purchase process [Walker, *e.g.*, col. 5, lines 8-19; and col. 6, lines 48+]. The codes in Walker appear to be used to access desired data, similar to a common "password" feature, and *not* to determine which incentives should be made available to a particular user [Walker, col. 6, lines 1-10]. Although Walker does disclose that the series of digits comprising session and purchase codes may optionally represent information such as a server ID number [Walker,

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e.g., col. 6, lines 55-59], Walker does *not* disclose, teach, or suggest using the server ID number (or any other information that may comprise the code) to make any sort of determination as to what incentives are available for a particular user. By contrast, Walker teaches that the use of unique codes is for security purposes [Walker, col. 6, lines 58-65]. There is simply no determination, in Walker, of available incentives based on unique codes. As such, Walker fails to cure the recognized deficiencies of Scroggie. The Examiner has failed to provide any evidence to the contrary.

For at least the foregoing reasons, the rejection of each of independent claims 1, 8, 11, 18, 21, 34, 39, 44, 48, 52-54, and 57 is clearly improper, is not supported by any proper factual basis, and is clearly legally deficient. The rejection must be reversed. All of the dependent claims are allowable because they each ultimately depend from an allowable independent claim, as well as for the further features they recite.

2. The Examiner's Newly Articulated Positions With Regard to the Claim Recitations of at Least Two (or a Plurality of) Network Servers are Legally Improper

As noted in the Appeal Brief [pgs. 55-60], most of the independent claims recite having an incentive host server and/or at least two (or a plurality of) network servers.<sup>3</sup> See independent claims 1, 8, 11, & 18 ("at least one incentive host server and at least two network servers"); independent claim 21 ("a host server" and "a plurality of network servers"); independent claim 39 ("an incentive host server" and "a plurality of network servers"); independent claim 44 ("a host server" and "a plurality of network servers");

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<sup>3</sup> Independent **claim 34** recites a "host server" and a "network server." Independent **claim 48** recites "a plurality of network server identifiers." Independent **claim 52** does not include the aforementioned recitations.

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independent claim 53 ("a plurality of network servers"); and independent claims 54 and 57 ("an incentive host server" and "at least two incentive network servers").

In the Answer, in an apparent recognition of the weakness of the rejection as it pertains to the claim recitations concerning the at least two (or a plurality of) network servers, the Examiner tries to salvage the rejection by advancing new positions, each of which is legally improper.

- a. ***The recitation of "at least two network servers" in independent claims 1, 11, and 18 should be accorded patentable weight.***

For the first time, in the Answer, the Examiner now indicates that the recitation of "at least two network servers" in each of independent claims 1, 11, and 18 has not been given patentable weight because this recitation occurs in the preamble of each of these claims and allegedly merely recites intended use [Answer, pgs. 17-18]. This contention is legally improper for at least the reason that this language breathes life and meaning into the claims when the claimed invention is considered as a whole.

The question of whether a preamble constitutes a limitation to a claim is a matter to be determined by the facts of each case in view of the claimed invention as a whole. See In re Stencel, 828 F.2d 751, 754, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). The preamble of a claim does not limit the scope of the claim when it merely states intended use of the invention. In re Pearson, 494 F.2d 1399, 1403, 181 U.S.P.Q. 641, 644 (C.C.P.A. 1974). However, terms in a preamble are construed as limitations when they give life and meaning to the invention claimed. Gerber Garment Tech., Inc. v. Lectra Sys., Inc., 916 F.2d 683, 688, 16 U.S.P.Q.2d 1436, 1441 (Fed. Cir. 1990) (quoting Perkin-Elmer Corp. v. Computervision

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Corp., 732 F.2d 888, 896, 221 U.S.P.Q. 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857 (1984)). Although no “litmus test” exists as to what effect should be accorded to terms appearing in a preamble, a patent application in its entirety should be reviewed to determine whether the inventors intended such language to represent additional limitations or mere introductory language. See, e.g., In re Paulsen, 30 F.3d 1475, 1479, 31 U.S.P.Q.2d 1671, 1673-74 (Fed. Cir. 1994) (citing Corning Glass Works v. Sumitomo Elect. U.S.A., Inc., 868 F.2d 1251, 1257, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989)).

The recitation of “at least two network servers” in the preamble of each of independent claims 1, 8, 11 clearly gives life and meaning to each of these claims. In particular, each of these claims positively recites that a NID is transmitted to the incentive host server, and is used to determine available incentives. The use of NIDs in Appellant’s incentive network enables users to access a common incentive host server through *different network servers* which increases a consumer’s exposure and access to incentives [Specification, *e.g.*, pg. 18, line 19 – pg. 19, line7]. In particular, a NID serves to identify from *which network server* (of among a number of network servers in Appellant’s incentive network) a request for incentives originated, so that incentives may be appropriately targeted or filtered for a user. The demonstrative diagram attached to the Appeal Brief [as **Attachment A**], and discussed therein, provides illustrative examples of how NIDs are utilized by the incentive host server to determine an appropriate subset of available coupons when a user requests incentives through *different network servers* (*e.g.*, a server hosting “Yahoo.com” or a server hosting “USAToday.com”) [Appeal Brief, pgs. 6-8; and **Attachment A**].

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As such, when the invention of each independent claims 1, 8, and 11 is considered *as a whole*, and when the claim recitations concerning the NID are considered in view of the recitation of the “at least two network servers” appearing in the preamble of each of the claims, it is clear that the recitation of the “at least two network servers” constitutes more than just “mere introductory language.” These recitations should therefore be accorded patentable weight when determining the patentability of independent claims 1, 8, and 11.

**b. *The Examiner’s new “duplication of parts” argument is without merit.***

In the Answer, the Examiner retreats from his previous interpretation of the teachings of Scroggie, and now *newly* recites that Scroggie discloses one network server, and *not* multiple (or at least two) network servers. Because the Examiner had previously relied on the teachings of Scroggie alone for the disclosure of at least two (or a plurality of) network servers, and *not* on any secondary references, the Examiner now attempts to salvage the rejection by improperly relying on a misplaced “duplication of parts” argument, and erroneously alleging that additional network servers provide no patentable significance. In particular, the Examiner recites:

Scroggie discloses one network server but does not disclose multiple (at least two) network servers. The limitation “multiple” is disclosed by In re Harza (legal precedent for duplication), 274 F.2d 669, 124 USPQ 378, 380 (CCPA 1960) which states “It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced”. See MPEP 2144.04(VI)(B). In this claim, duplicating the part does not produce any new result and does not produce any unexpected result.

[Answer, pg. 18].

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This contention is without merit, and trivializes Appellant's invention. As noted in the Appeal Brief [*e.g.*, at pgs. 9-10], the benefits that flow from Appellant's network architecture [*e.g.*, a (common) incentive host server, as well as at least two (or a plurality of) network servers], in the context of a coupon distribution system, are not disclosed in the alleged prior art relied upon by the Examiner. A plurality of network servers provides consumers with more than one avenue to participate in the incentive system, and may result in *different incentives* based on the network identifiers (NIDs) associated with the *different network servers* in the incentive network (and/or the UIDs). In this regard, the specification recites:

By providing in each network server an access mechanism to the incentive server, client systems requesting documents from a network server are presented with information on selected incentives. For example, a consumer who frequents more than one general http site (often referred to as "Web portals") such as Yahoo.com and USAToday.com may access his/her available incentives through both those sites. ***This increases the consumer's exposure and access to the incentives without being intrusive. It also facilitates the provision of personalized information for the consumer on both sites without the need to create separate accounts on each site.***

[Specification, pg. 18, line 19- pg. 19 line 7, ***emphasis added***].

Even though two requests may be made from the same client device, the subset of coupons presented in response to those requests may differ based on filtering parameters associated with the *different network servers* through which the user made the request. The advantages realized and the *different outcomes* that may result when users access the (common) incentive host server through *different network servers* illustrates how the implementation of at least two (or a plurality of) network servers clearly amounts to more

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than just a “mere duplication of parts” as the Examiner erroneously alleges.

For at least the reason that the Examiner’s “duplication of parts” argument is legally improper, and because the Examiner (according to this newly articulated position) does not rely on Scroggie (or any other references) for the teaching of at least two (or a plurality of) network servers, the Examiner has failed to satisfy his burden with regard to at least this claim feature. Accordingly, the rejection is improper and should be reversed.

**c. *The incentive distribution server (300) of Scroggie does not satisfy the claim recitations of Appellant’s (incentive) network server.***

To the extent that the Examiner is relying on the incentive distribution server (300) of Scroggie as allegedly comprising one of Appellant’s claimed network servers for the rejection of independent **claim 1** [Office Action, pg. 3; Answer, pg. 3], independent **claim 8** [Office Action, pg. 7; Answer, pg. 7 & pg. 18], independent **claim 21** [Answer, pg. 18], independent **claim 54** [Office Action, pg. 10; Answer, pg. 11 & pg. 18], and/or independent **claim 57** [Office Action, pg. 13; Answer, pg. 14 & pg. 18], the Examiner’s rejection is further legally flawed because the incentive distribution server (300) of Scroggie does *not* satisfy various claim recitations pertaining to transmissions from the claimed network server to the claimed incentive host server. *See, e.g.*, independent claim 1 (“transmitting a first identifier and a network server identifier (NID) corresponding to the access request to the incentive host server”); independent claim 8 (“transmitting a first identifier and a network server identifier (NID) corresponding to the access request to the incentive host server”); independent claim 21 (“providing identifying information including a first identifier and a network server identifier (NID) to the host server, wherein the identifying information is



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used by the incentive distribution module, at least in part, to identify available incentives associated with the NID"); independent claim 54 ("incentive host server comprising...an incentive determination module for...receiving a request for incentives from any of the incentive network servers; receiving a UID and a Network ID (NID) associated with the request"); and independent claim 57 ("wherein the incentive host server comprises...a network interface for receiving from any of the incentive network servers a request for access to at least some of the stored incentives, and for receiving with the request a Network ID (NID) associated with the incentive network server from which the request is received").

Scroggie's incentive distribution server (300) does *not* satisfy these claim recitations.

Rather, Scroggie discloses the following "transmissions" made by server (300):

(a) The server 300 transmits purchase incentive data to an in-store server 310 in the supermarket selected by the user 308, which gives the user an appropriate discount automatically when he or she presents items for checkout and a point-of-sale checkout scanner 312, with appropriate identification recognized by the in-store server 310. Promotions or discounts are given to the customer, as indicated at 314. The server 300 may also send an advisory message to the customer to confirm the existence of the promotion.

(b) The server 300 transmits the image of a token 316 of some kind to the user's computer 302. The token defines the coupon offer, preferably in coded form, such as in bar codes, but is not recognizable as a coupon. The token may, for example, be an encoded confirmation number. The user 308 presents the token 316 at the store he or she has selected, and receives the appropriate discount or promotion automatically.

[Scroggie, col. 11, line 57 – col. 12, line 6].

Nowhere in the foregoing passages does Scroggie disclose transmission of a NID (as

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disclosed and claimed by Appellant) by the incentive distribution server (300).

For at least the foregoing reason, the rejection of *at least*<sup>4</sup> independent claims 1, 8, 21, 54, and 57 under 35 U.S.C. § 103(a) is improper and should be reversed. Any dependent claims which depend therefrom are allowable by virtue of their dependency, as well as for the further features they recite.

**d.     *The in-store server (or kiosk) (310) of Scroggie does not satisfy the claim recitations of Appellant's (incentive) network server.***

To the extent that the Examiner is relying on the in-store server (or kiosk) (310) of Scroggie as allegedly comprising one of Appellant's claimed network servers for the rejection of independent **claim 21** [Office Action, pg. 9; Answer, pg. 9], the Examiner's rejection is further legally flawed because the in-store server or kiosk (310) of Scroggie does *not* satisfy the claim recitations of Appellant's (incentive) network server. In particular, as noted in the Appeal Brief [pgs. 59-60], the in-store server (or kiosk) (310) of Scroggie [Scroggie, col. 11, lines 57-65] fails to disclose the following recitation of independent claim 21: "providing identifying information including a first identifier and a network server identifier (NID) to the host server, wherein the identifying information is used by the incentive distribution module, at least in part, to identify available incentives associated with the NID." The Examiner has failed to establish how this claim recitation is satisfied by

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<sup>4</sup> As noted above, the Examiner *may* be relying on the rejection of independent claim 1 for the rejection of independent claim 11, as claim 11 includes similar features [Office Action, pg. 8; Answer, pg. 9]. If this is the case, then the rejection of claim 11 is legally improper for the same reasons as the rejection of claim 1. It is not clear to Appellant what the Examiner is relying on for the rejection of independent claims 18, 34, 39, 44, 48, and 52-53 [Office Action, pg. 10; Answer, pg. 11].

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the in-store server (or kiosk) (310). The Examiner has failed to even address this deficiency in the Answer.

For *at least* this reasons, the in-store server (or kiosk) (310) is not a network server as claimed. Accordingly, the rejection of independent claim 21 under 35 U.S.C. § 103(a) is improper and should be reversed. Dependent claims 31-33 are allowable because they depend from allowable independent claim 21, as well as for the further features they recite.

- e. ***The Point-of-Sale (POS) Checkout Scanner (312) of Scroggie does not satisfy the claim recitations of Appellant's (incentive) network server.***

To the extent that the Examiner is relying on the Point-of-Sale (POS) checkout scanner (312) of Scroggie as allegedly comprising one of Appellant's claimed network servers for the rejection of independent **claim 1** [Office Action, pg. 3; Answer, pg. 3], independent **claim 8** [Office Action, pg. 7; Answer, pg. 7], independent **claim 21** [Office Action, pg. 9], independent **claim 54** [Office Action, pg. 10; Answer, pg. 11], and/or independent **claim 57** [Office Action, pg. 13], the POS checkout scanner (312) of Scroggie does *not* satisfy the claim recitations of Appellant's (incentive) network server for the reasons previously set forth in the Appeal Brief [pgs. 57-59].

In the Answer, the Examiner fails to even address Appellant's argument that a point-of-sale checkout scanner is *not* a network server, much less a device through which a consumer makes requests for access to coupons from an incentive host server. A person of ordinary skill in the relevant art would recognize that scanner (312) is simply a peripheral device that is used to read a bar code on a given product at the checkout line in the store.

The Examiner further fails to address Appellant's argument that, even if a scanner

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were misconstrued to be a network server, no "client device" in Scroggie makes an access request for incentives from scanner (312). Appellant's claimed network servers, by contrast, receive access requests for incentives from client devices [*see discussion of specific claim recitations in Appeal Brief, pg. 58*].

Nor does the Examiner address Appellant's argument that, even if a scanner were misconstrued to be a network server, the point-of-sale checkout scanner (312) of Scroggie fails to satisfy various additional claim recitations pertaining to transmissions from the claimed network server to the claimed incentive host server [*see discussion of specific claim recitations in Appeal Brief, pgs. 58-59*].

For the foregoing reasons, the rejection of *at least*<sup>5</sup> independent claims 1, 8, 21, 54, and 57 under 35 U.S.C. § 103(a) is improper and should be reversed as the relied upon point-of-sale checkout scanner (312) of Scroggie fails to satisfy various additional recitations pertaining to the claimed network server. Any dependent claims which depend therefrom are allowable by virtue of their dependency, as well as for the further features they recite (discussed below).

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<sup>5</sup> Again, to the extent that the Examiner *may* be relying on the rejection of independent claim 1 for the rejection of independent claim 11, then the rejection of claim 11 is legally improper for the same reasons as the rejection of claim 1. It is not clear to Appellant what the Examiner is relying on for the rejection of independent claims 18, 34, 39, 44, 48, and 52-53 [Office Action, pg. 10; Answer, pg. 11].

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3. Dependent Claims 2-7, 9-10, 12-17, 19-20, 22-33, 35-36, 40-41, 45-47, 49-50, 55-56, and 58-59.

The Examiner additionally rejected dependent claims 2-7, 9-10, 12-17, 19-20, 22-33, 35-36, 40-41, 45-47, 49-50, 55-56, and 58-59 under 35 U.S.C. § 103(a) over Scroggie in view of Walker [Office Action, pg. 3, ¶4; Answer, pg. 3, ¶2]. In the Answer [at pgs. 18-25], the Examiner does not substantively address Appellant's arguments concerning various dependent claims [Appeal Brief, pgs. 60-66], but rather appears to have merely "cut and pasted" the same rejections from the Office Action. Accordingly, Appellant maintains the arguments previously presented in the Appeal Brief. Additionally, for the reasons set forth in detail above regarding Walker (as non-analogous art), as well as the legally improper (and deficient) combination of Scroggie and Walker, the rejection of *each* of the pending independent claims is improper and should be reversed. Accordingly, dependent claims 2-7, 9-10, 12-17, 19-20, 22-33, 35-36, 40-41, 45-47, 49-50, 55-56, and 58-59 are allowable because they depend from an allowable independent claim, as well as for the further features they each recite.

4. Claims 37-38, 42-43, and 51 are Patentable Over the Combination of Scroggie and Walker, Further in View of Gardenswartz.

For the reasons set forth in detail above regarding Walker (as non-analogous art), as well as the legally improper (and deficient) combination of Scroggie and Walker, the rejection of *each* of the pending independent claims -- including independent claims 34, 39, and 48-- is improper and should be reversed. Accordingly, dependent claims 37-38 are allowable because they depend from allowable independent claim 34, as well as for the further features they recite. Dependent claims 42-43 are allowable because they depend

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from allowable independent claim 39, as well as for the further features they recite.

Dependent claim 51 is allowable because it depends from allowable independent claim 48,  
as well as for the further features it recites.

**CONCLUSION**

Appellant now appeals to this Honorable Board to promptly reverse all rejections of  
claims 1-59, and issue a Decision in favor of Appellant. All of the claims are in condition for  
allowance.

Date: October 21, 2008

Respectfully submitted,

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